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EXAMINER

MATTISON, LORI K

ART UNIT	PAPER NUMBER
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1619

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/584,727	Applicant(s) SAKAKIBARA, ITSUO	
	Examiner LORI MATTISON	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/15/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-11, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/03/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-20 are pending. Claims 9-11, 14, and 15 are withdrawn being drawn to an unelected invention (i.e. a method of making the composition).

2. Applicant's amendments to claims 1-10, filed 7/15/2009 are acknowledged.

Claims 11-20 are new.

Claims 1-8, 12, 13, and 16-20 are pending and examined on the merits.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Objections and rejections not recited in this action are withdrawn.

5. References not included with this Office action can be found in a prior action.

Claim Objections

Instant claim 7 is objected to because the word “claim” in line 1 has been deleted, resulting in a grammatical error. Instant claim 7 literally reads, “The composition of 5, wherein said...”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 18-20 are indefinite because the metes and bounds of the claims are unclear. Instant claims 18-20 recite that the water-soluble organic medium is wax, animal fat, and Vaseline, respectively. This is unclear because the evidentiary references “wax” (page 1, definition 1), “animal fat” (page 1, paragraph 1) and Vaseline (page 2, paragraph 5) disclose that wax, fats, and vaseline are all water insoluble.

Claim Rejections - 35 USC § 103

Claims 1-8, 12, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/083031 (Creutz, 2003), WO 00/12669 (Aldcroft, 2000), and the *American Library Edition of Workshop Receipts Vol 1* by Sop as evidenced by the MSN Encarta dictionary for powder and the Compact Oxford English Dictionary definition for granule.

Applicant's amendment necessitated the new grounds of rejection because the phrase “consisting essentially of” overcame the teachings of the prior art which required inclusion of peroxides, persulfates, and/or dyes which do not contribute to improving the gloss and shine of the hair. Improvement of gloss and moisture through use of the

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recited composition is taught to be a novel aspect of the invention as taught by the Applicant at page 1, paragraph 1 and page 5, paragraph 22 of the instant specification.

Creutz teaches a composition which provides a controlled release of fragrance (abstract). Creutz teaches that the formulation comprises a fragrance, wax, and a liquid silicone (page 7, paragraph 25; instant claim 1). The wax is solid at room temperature because Creutz teaches that the composition needs to be melted so that it may be deposited on a solid carrier (page 7, paragraph 25; instant claim 1). Sodium carboxymethylcellulose is taught among a list of suitable particulate (i.e. particle) solid carriers (page 7, paragraph 25; instant claims 1-3 and 7). The treated carrier particles are agglomerated into granules (page 7, paragraph 26; instant claim 2). As evidenced by the MSN Encarta dictionary definition for powder, "powder" is defined as loose dry particles (instant claim 2). As evidenced by the Compact Oxford English Dictionary, a granule is a small compact particle of substance. Thus, a collection of granules is a powder (instant claim 2). Creutz teaches that the waxes, such as waxy fatty acids, delay the release of fragrance but occludes the fragrance so much that it is never released (page 9, paragraph 35). Inclusion of a liquid silicone decreases the high occlusivity of the fatty acid, increasing odor precipitation (page 9, paragraph 35). Creutz teaches that the perfume comprises up to 15% of the granules (page 8, paragraph 28). The composition of example 1 comprises 5 grams perfume, 10 grams waxy material and 5 grams liquid silicone (page 9, paragraph 33), thus teaching that the particle carrier would comprise 13 grams of the composition. Creutz specifically teaches that the fragrance compositions may be applied to laundry detergents, household cleaning

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products, fabric softeners, hair shampoos, soaps, shower gels, antiperspirants, deodorants, air fresheners and drier sheets (page 1, paragraph 1). Creutz teaches that the waxes included in his composition are organic waxes (page 3, paragraph 13).

Creutz does not immediately embody a water dispersible medium in the solid perfume particles as set forth by instant claim 1.

Creutz does not immediately embody a carboxymethylcellulose as the water soluble organic medium as set forth by instant claim 3.

Creutz does not teach a composition wherein the water soluble material is in a range of 10-100 parts by weight with respect to 100 parts by weight of said oily material as set forth by instant claim 4.

Creutz does not teach that his solid composition is dissolved or dispersed in water as set forth by instant claim 5.

Creutz does not teach that the water soluble medium is carboxymethylcellulose as set forth by instant claim 7.

Creutz does not teach a composition in which the water-soluble organic medium is present in a range of 10-100 parts by weight with respect to 100 parts by weight of said oily material as set forth by instant claim 8.

Creutz does not teach that his composition is dissolved in water as set forth by instant claim 12.

Creutz does not tech that his composition is dispersed in water as set forth by instant claim 13.

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Creutz does not teach a composition in which the water-soluble organic medium is present in 10 parts by weight with respect to 100 parts by weight of said oily material as set forth by instant claim 16.

Creutz does not teach a composition in which the water-soluble organic medium is present in 10 parts by weight with respect to 100 parts by weight of said oily material as set forth by instant claim 17.

Creutz does not teach that the oil material is rosin as set forth by instant claim 6.

Aldcroft teaches granular powders which may be incorporated into laundry powders (title, abstract). The granular compositions are formulated to carry liquid fragrances and perfumes (page 1, lines 1-10). Aldcroft teaches that his particles comprise a dispersing agent which swell in the presence of water (page 5, lines 20-35). Aldcroft teaches that sodium carboxymethylcellulose is a water swelling dispersant (page 5, lines 20-35).

The American Library Edition of Workshop Receipts Vol 1 teaches that rosin, when incorporated with a soap, will make the soap more deterative and soluble (page 2 of 5, paragraph 3).

With regard to instant claims 1, 3, 5, 7, 12, and 13, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention to have looked to Creutz's teachings and selected sodium carboxymethyl cellulose from the list provided by Creutz to serve as the solid particulate carrier in order to better release the fragrance and reduce the wax's fragrance occlusivity in the presence of water because Creutz teaches his solid fragrance composition for use in laundry detergents and

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Aldcroft teaches that sodium carboxymethylcellulose granular carriers, used in laundry detergents, swell and disperse in the presence of water. The skilled artisan would have been motivated to swell, disperse and/or dissolve the composition in water in order to release the fragrance and remove dirt by utilizing the laundry detergent taught by the combined references of Creutz and Aldcroft to wash clothing.

With regard to the composition having the property of being able to disperse or dissolve in water as set forth by instant claim 1, it would naturally flow that the solid perfume composition taught by Creutz, when utilizing sodium carboxymethylcellulose, would dissolve and disperse in water via the same scientific principles as taught at page 6, paragraphs 24-25 of the instant specification because the same reagents are present in the composition.

With regard to instant claims 4, 8, 16, and 17, the adjustment of particular conventional working conditions [e.g. determining result effective amounts of sodium carboxymethylcellulose (i.e. organic medium) and wax (i.e. solid oily material)] is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the ordinary artisan with said artisan recognizing that sodium carboxymethylcellulose swells and disperses in water, as taught by Aldcroft, which would affect the release of perfume from the laundry detergent in the presence of water used in the washing cycle. The artisan of ordinary skill would have been motivated to formulate the composition with low or high amounts of sodium carboxymethylcellulose in order to have a formulation which would either dissolve very well and quickly in water when carboxymethylcellulose was used in a high concentration or provide more of a

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deposition of the wax, fragrance, and silicone onto the textile fabric when carboxymethylcellulose was used in a lower concentration due to lower and less rapid dissolution of the laundry detergent granule.

With regard to instant claim 6, it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have added rosin to the composition of Creutz because Creutz teaches that his composition may comprise any organic wax and be used in a laundry detergent and rosin is an organic wax that was known to be beneficial when used in conjunction with soaps, making the soap more deterative as taught by the *American Library Edition of Workshop Receipts Vol 1*. The skilled artisan would have been motivated to do so in order to improve the performance and deterative properties of the laundry detergents in which the fragrance composition is incorporated into.

Response to Arguments

Applicant alleges that the new claim language overcomes the anticipation and obviousness rejections over Lorenz because Lorenz teaches/requires inclusion of dyestuffs and peroxides which would affect the basic and novel characteristics of the instant composition (i.e. providing gloss and moisture; page 8, paragraphs 1-3; and page 9, paragraph 1).

Applicant's arguments regarding the withdrawn art rejections of record have been considered to the extent they read on the new grounds of rejection.

It is noted that M.P.E.P. § 2105 states:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the

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basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components. In finding the claims did not exclude the prior art dispersant, the court noted that appellants' specification indicated the claimed composition can contain any well-known additive such as a dispersant, and there was no evidence that the presence of a dispersant would materially affect the basic and novel characteristic of the claimed invention. The prior art composition had the same basic and novel characteristic (increased oxidation resistance) as well as additional enhanced detergent and dispersant characteristics.). "A consisting essentially of" claim occupies a middle ground between closed claims that are written in a consisting of format and fully open claims that are drafted in a comprising format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). See also Atlas Powder v. E.I. duPont de Nemours & Co., 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); In re Janakirama-Rao, 317 F.2d 951, 137 USPQ 893 (CCPA 1963); Water Technologies Corp. vs. Calco, Ltd., 850 F.2d 660, 7 USPQ2d 1097 (Fed. Cir. 1988). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

Creutz teaches a composition which may comprise the water soluble organic solvent, carboxymethylcellulose, a wax (i.e. oily material that is solid at room temperature), and a silicone oil (page 7, paragraph 25). Creutz embodies use of DC 556 (phenyl trimethicone) as the liquid silicone for use in the composition (Example 1, page 9, paragraph 33). As evidenced by US Publication No. 2002/0015681 (Carballada, 2002), phenyl trimethicone is a silicone conditioning agent with a high refractive index which provides glossiness to the hair when used in hair compositions (page 7, paragraph 101). Therefore, the inclusion of the liquid silicone of Creutz would not be detrimental to the novel or inventive concept (i.e. a composition which provides gloss, shine, and moisture to the hair; instant specification, page 1, paragraph 1). Also,

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Example VI demonstrates that perfume (i.e. fragrance) may be utilized in conjunction with phenyl trimethicone (page 11, paragraph 167). Carballada does not disclose that the perfume interfered with the gloss enhancing properties of the phenyl trimethicone. Therefore, perfume/fragrance would not interfere with the novel aspects of the present invention.

It is observed that the instant claims do not require the composition to be a composition for hair. It is also noted that the "consisting essentially of" claim language does not entirely close claim to additional reagents. Applicant may wish to consider whether it is appropriate to amend the claim language to utilize the closed transitional phrase, "consisting of" to overcome the combined references applied above. Support for such an amendment can be found in the Example on page 10, paragraph 39 of the instant specification.

Conclusion

No claims are allowed. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M./

Examiner, Art Unit 1619

/Anne Marie Grunberg/

Supervisory Patent Examiner, Art Unit 1661